4-02-03

#17 4/8/03 RW

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant : | Robin R. Miles, et al. | Docket No. : | IL-10406 |
| Serial No. : | 09/737,542 | Art Unit : | 1641 |
| Filed : | December 14, 2000 | Examiner | K. Padmanabhan |
| For : | Impedance Measurements for Detecting Pathogens Attached to Antibodies | | |

**CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)**

I hereby certify that the *attached* correspondence comprising:

1. Request For Reconsideration (4 pages)
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on 3-31-03

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## REQUEST FOR RECONSIDERATION

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed on January 2, 2003, kindly consider the following:

The 35 USC 103 Rejections

Claims 10, 12-18, and 21-28 are rejected under 35 USC 103(a) as unpatentable over van Gerwen et al. In this reference, the electrodes are located across the channel from each other and not located on the same said and in spaced relation along a length of said channel as set forth in Claims 10, 16, and 24. In addition, this reference fails to teach the features of Claims 12-14, 17, 18, and 21-28 since both electrodes of the references are not located on the same surface of the channel as clearly seen in 6a – 6b and 7a – 7b. Where are the features of Claims 22, 23, 25 and 28 taught? Thus, this reference fails to teach each feature set forth in Claims 10, 12-18, and 21-28, and thus fails to support a rejection of these claims under 35 USC 103. The Examiner contends that it would be obvious to place the electrode pair on the same side of the microchannel. This is not a mere rearranging of parts as discussed in In re Japikse, cited by the Examiner. If so obvious cite prior art.

Why not?

Claims 10, 12-13, 16 and 20-26 are rejected under 35 USC 103(a) as unpatentable over Clark et al in view of Kipling et al. Claims 10, 16, and 24 set forth that the electrodes are located on a same surface and spaced along a length of the fluidic channels, which feature is not taught by either references. Where are the features of Claims 22, 23 and 25 taught? The Examiner contends that it would be obvious to use the antibodies on the surfaces of the electrode, and that it would be obvious to place the electrode pair on the same side of the microchannel. If so obvious, the Examiner is called up to cite prior art showing this feature. In addition, the Examiner incorrectly contends that placement of the electrodes on a bottom surface of the microchannel would be obvious optimization. The Examiner is called upon to cite prior art showing this feature.

Claims 11, 14, 17-19 and 27-28 are rejected under 35 USC 103(a) as unpatentable over Clark et al in view of Kipling et al and further in view of Taylor et

al. These claims depend from either Claim 10 or Claim 16 or Claim 24. As pointed out above, neither the primary or secondary references teach or suggest the feature added to parent Claims 10, 16, and 24. The reference Taylor et al also fails to teach or suggest this added feature. The Examiner contends that it would be obvious to use the reference electrodes and insulating layer, as well as interdigitated electrode.

Claim 15 is rejected under 35 USC 103(a) as being unpatentable over Clark et al in view of Kipling et al, and further in view of Stetter et al. As pointed out above, neither Clark et al or Kipling et al teach the electrode arrangement set forth in parent Claim 10. Stetter et al was applied to teach the use of an AC power source, and the addition of such a source to Clark et al would not teach or suggest the features of Claim 15 which includes the features of parent Claim 10. Thus, this rejection should be withdrawn.

Claims 11 and 19 are rejected under 35 USC 103(a) as unpatentable over van Gerwen et al in view of Taylor et al. These claims depend from Claims 10 and 16 and as pointed out above, the primary reference fails to teach the feature added to the parent claims. Taylor et al also fails to teach this added feature. If it is so obvious to use a reference electrode in an insulating layer, then the Examiner is called upon to cite appropriate references to teach this feature. not needed.

## Conclusion

It is submitted that in view of the foregoing, the applied references fail to teach or suggest, either expressly or impliedly, the features set forth in the claims so rejected. While the claimed features may appear to be obvious to the Examiner, after having had access to Applicants, disclosure such "obvious" feature if obvious should be taught by the prior art. It is requested that the Examiner cite prior art to support these numerous holdings of obviousness. It is submitted that this application is in condition for allowance based on Claims 10-28.

Respectfully submitted,

Dated: 3-31-03

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**Washington, D.C. 20231**



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